APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,126	01/02/2002	Vikrant Sharma	3790-012018	7425

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EXAMINER
NGUYEN, THANH T

ART UNIT	PAPER NUMBER
2144	

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/038,126	SHARMA, VIKRANT
	Examiner	Art Unit
	Tammy T Nguyen	2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *(3)* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *02 January 2002*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-25* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-25* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *02 January 2002* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *4/16/02*.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

UNITED STATES PATENT AND TRADEMARK OFFICE

Detailed Office Action

1. This action is in response to the application **10/038,126** filed. **January 2, 2002**

2. Claims **1-25** have been examined.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
patent by another filed in the United States before the invention by the applicant for patent, except that an
international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
subsection of an application filed in the United States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 8-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaw et al.

(USPN 6,199,106)– Date of Patent: March 6, 2001, herein referred to as "Shaw").

5. As to claim 1, Shaw teaches the invention as claimed, including a system for delivering email-based advertising to discrete users, comprising: (a) a first computer connected to a computer network, the first computer configured to transmit an email message (computer 101 of fig.1); (b) a second computer connected to the computer network, the second computer configured to receive the email message from the first computer, the second computer responsive to the email message, at least one of the first and second computers being configured to transmit identification data and optionally one or more email client objects (external parties, col.9, lines 35-51); and (c) at least one server in the computer network, the server configured to receive the identification data and optionally one or more of the email client objects, the server being responsive to the identification data and optionally one or more of the email client objects, by selecting an advertisement, the server configured to transmit the advertisement to the first or second computer, so that the second computer may display the advertisement in a text window of the email message (see col.12, lines 43-60, col.13, lines 11-28).

6. As to claim 8, Shaw teaches the invention as claimed, wherein the identification data and optionally one or more of the email client objects is transmitted to the server by the second computer (Fig.1).

7. As to claim 9, Shaw teaches the invention as claimed, wherein the server is a banner server, the banner server is programmed to select an appropriate advertisement as a function of the identification data and optionally one or more of the email client objects (fig.8).

8. As to claim 10, Shaw teaches the invention as claimed, wherein the banner server is comprised of at least the following: (a) a web server; (b) an application server; and (c) a database backend (application server 104 of fig.1)

9. As to claim 11, Shaw teaches the invention as claimed, wherein the server is configured to provide an advertisement and optionally an active link associated with the advertisement, to be transmitted to the second computer (see col.19, lines 9-39).

10. As to claim 12, Shaw teaches the invention as claimed, wherein the first computer and the second computer is configured to utilize instant messaging software or wireless communication software to communicate email messages to and from each other (see col.6, lines 15-40).

11. As to claim 13, Shaw teaches the invention as claimed, including a method of delivering email-based advertising between a first computer and a second computer on a network, the method comprising the steps of: (a) transmitting (by either the first computer or the second computer) identification data and optionally one or more email client objects to a server on the network (Fig.4 communication connect between client and server, fig.8) (see col.4, lines 40-52, and col.9, lines 35-51); (b) receiving in the server, the identification data and optionally one or more of the email client objects (Fig.12); (c) selecting an advertisement by means of the server (selecting advertisements 108 of fig.6); (d) transmitting the advertisement to the second computer (recipient email with ads of fig.12); and (e) embedding the advertisement in a text window of an email message, to be displayed on a screen of the second computer (message sent with ads of fig.12).

12. As to claim 14, Shaw teaches the invention as claimed, wherein the email message is sent from the first computer to the second computer and the identification data, and optionally one or more email client objects is sent from the second computer to the server (see fig.8).

13. As to claim 15, Shaw teaches the invention as claimed, wherein the server selects an advertisement, based on the identification data and optionally one or more of the email client objects, and sends an advertisement to the second computer, wherein the second computer then attaches the advertisement to the email message so that the advertisement appears in the text window of the email message (see fig.12).

14. As to claim 16, Shaw teaches the invention as claimed, wherein the identification data is an affiliate I.D. number and the optional email client objects include at least a subject line (Subject 1204 of fig.1204).

15. As to claim 17, Shaw teaches the invention as claimed, wherein the server counts the number of times a particular ad is pulled and sent for attachment to an email message (time of fig.10).

16. As to claim 18, Shaw teaches the invention as claimed, wherein the server utilizes counting software to limit the number of times a particular recipient of an email message sees the same ad (status 1002 of fig.10).

17. As to claim 19, Shaw teaches the invention as claimed, wherein the server credits a partner, with reference to the identification data, for each time an advertisement is viewed by a unique recipient (recipient 1202 of fig.12).

18. As to claim 20, Shaw teaches the invention as claimed, wherein the server instructs billing software to generate a payment, either in the form of electronic payment or printed check, to a partner based on the number of advertisements placed by the server in connection with that partner's identification data (see fig.12).

19. As to claim 21, Shaw teaches the invention as claimed, wherein the server works in conjunction with billing software to generate bills for advertisers whose advertisements are placed by the server, based on the number of times the advertisements are sent from the server for attachment to an email message (text message with ads shown in fig.12)..

20. As to claim 22, Shaw teaches the invention as claimed, wherein, in addition to the advertisement, the server sends an active link (URL) to enable a recipient to click on the advertisement and access the advertiser's website (URL 800 of fig.12).

21. As to claim 23, Shaw teaches the invention as claimed, wherein the advertisement is one of text and graphics (text 1205, graphic 801 of fig.12).

22. As to claim 24, Shaw teaches the invention as claimed, wherein the advertisement includes an active link associated therewith (link 800 of fig.12).

23. As to claim 25, Shaw teaches the invention as claimed, including an email message interface comprised of a "from" field (from 815 of fig.8) a "To" field (to 1202 of fig.12), a "Subject" field (subject 1204 of fig.12), and an email message text window (message text window 1205 of fig.12), wherein a Person-to-Person message and an advertising banner are displayed within the email message text window (banner 800 of fig.12), further wherein the advertising banner has an active link associated therewith (link 800 of fig.12).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

25. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al.,

(hereinafter Shaw) U.S. Patent No. 6,199,106 in view of Franco et al., (hereinafter

France) U.S. Patent No. 6,687,746.

26. As to claim 2, Shaw does not explicitly teach a mail client configured to embed HTML

code into the email message. However, Franco discloses a mail client configured to

embed HTML code into the email message (see col.10, lines 17-40). It would have been

obvious to one of ordinary skill in the art at the time of the invention was made to

implement the teachings of Franco into the computer system of Shaw to have a mail

client configured to embed HTML code into the email message because it would have an

efficient system that can provide specific functions to format and layout the information

in a Web page.

27. As to claim 3, Shaw teaches the invention as claimed, wherein the email message is

comprised of the HTML code, the HTML code comprised of the identification data and

optionally one or more of the email client objects (fig.1).

28. As to claim 4, Shaw teaches the invention as claimed, wherein the affiliate I.D. number identifies a partner, the partner being a user of the first computer system (member profile of fig.7).

29. As to claim 5, Shaw teaches the invention as claimed, wherein the email client objects comprise at least one of the following: (a) a recipient's email address; (b) a subject line; (c) a time of the day; (d) an IP address; and (e) a profile of the partner (a recipient's email address of fig. 12).

30. As to claim 6, Shaw does not explicitly teach a second email client comprised of an HTML interpreter, the HTML interpreter configured to interpret the HTML code. However, Franco discloses a mail client configured to embed HTML code into the email message (see col.10, lines 17-40). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Franco into the computer system of Shaw to have a mail client configured to embed HTML code into the email message because it would have an efficient system that can provide specific functions to format and layout the information in a Web page.

31. As to claim 7, Shaw does not explicitly teach an identification data and optionally one or more of the email client objects are read from the HTML code. However Franco disclose HTML code (see col.10, lines 17-40). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Franco into the computer system of Shaw to have a mail client configured to embed HTML code into the email message because it would have an efficient system that can provide specific functions to format and layout the information in a Web page.

Conclusion

32. Any inquiries concerning this communication or earlier communications from

the examiner should be directed to **Tammy T. Nguyen** who may be reached via telephone at

(571) 272-3929. The examiner can normally be reached Monday through Friday between 8:00

a.m. and 5:00 p.m. eastern standard time.

If you need to send the Examiner, a facsimile transmission regarding this

instant application, please send it to **(703) 872-9306**.   If attempts to reach the examiner by

telephone are unsuccessful, the Examiner's Supervisor, Bill Cuchlinski, may be reached at **(571)**

272-3925.

TTN

February 4, 2005

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